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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MALLOY & MALLOY, P.A.
2800 S.W. Third Avenue
Historic Coral Way
Miami, FL 33129

EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062,178

Applicant(s)

HELLENKAMP, JOHANN F.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/22, 7/7, 8/8, 12/30.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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In order for applicant to properly claim priority to earlier applications, the first line of the specification must be amended to indicate the relationship (e.g. continuation or continuation in part) between the current application and the earlier applications.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-7 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 2, lines 14-15 are confusing and inaccurate since the narrow neck (between the flanged portion 329 and the main portion of the blade holder 320) which is located within the blade aperture 319 engages the edge of the aperture. However, the flanged portion 329 itself engages the bottom of the blade rather than the edge of the aperture. Claims 3 and 11 are indefinite for the same reason. In claim 2, line 17, there is no antecedent basis for "said underside of said blade". Claim 4 is indefinite for the same reason.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mueller ("The Surgical Armamentarium"). Mueller, as shown on the attached appendix, discloses a blade (blade No. 25 shown on page 3) having a blade holder (handle F shown on page 2), the blade front portion having an overall dimension which is larger than the rear portion, the blade having an edge (at the central opening) for engaging the blade holder, the underside of the blade holder having a flanged portion (the flange at the tip of the handle which passes through the opening in the blade), the underside of the blade holder (i.e. the side

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of the handle facing the viewer of the figure) being inclined at an angle with respect to the top side (at the tapered portion which extends diagonally from the bottom left to the top right as seen in the figure and which is inclined relative to the plane of the paper), said top side adapted to be driven by a pin (since the top side, i.e., the side opposite to that which is shown in the figure, like the underside, has a recess extending longitudinally along the handle which is inherently capable of receiving a pin to move the handle). The Muller device is inherently capable of being used to cut the cornea. Alternatively, it would have been obvious that the Muller device is capable of being used to cut the cornea since it is a surgical blade. As to claim 6, the cutting edge on blade No. 25 is wider than the thickness dimension of the rear blade portion. As to claim 10, Mueller discloses a blade (blade I shown on page 5) having a blade holder (handle D shown on page 5), the rear portion of the blade including a side edge (the blunt edge at the top of the figure) which is tapered with respect to the cutting edge, the blade holder top side including a recess (The top side, i.e., the side opposite to that which is shown in the figure, like the underside, has a recess extending laterally across the handle, apparently for gripping purposes, which is inherently capable of receiving a pin to move the handle.), the

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blade holder including a sidewall which generally tapers from the front to the back of the blade holder (since the width of the blade holder gradually decreases from the top towards the bottom of the figure). As to claim 13, blade No. 24 on page 3 has a generally rounded taper near the top right portion of the figure. As to claim 24, Mueller shows a handle (at the forceps shown at E on page 4) which is removably connected to the blade holder when it grasps it. As to claim 25, the Mueller blade is inherently capable of avoiding interference with movement of a cutting head assembly appropriately dimensioned.

Claims 2-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-68 of U.S. Patent No. 6,051,009. Although the conflicting claims are not identical, they are not patentably distinct from each other because the slight difference in wording in the claims involves an obvious difference.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
6/17/04



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731